

REMARKS

Claims 1-8, 14, 17 and 18 were rejected in a final Office Action mailed 6/16/2005.

A Response under 37 CFR 1.116 was received in the USPTO 9/22/2005.

An Advisory Action mailed 11/2/2005 indicated that the Response under 37 CFR failed to place the application in condition for allowance. Consequently a Notice of Appeal was mailed 10/14/2005.

In reviewing the Advisory Action, in preparation for filing an Appeal Brief, it was noticed that the Advisory Action failed to check the appropriate box in paragraph 7 to indicate whether or not the proposed amendments in the Response under 37 CFR 1.116 were entered. Accordingly, it must be assumed that the proposed amendments in the Response under 37 CFR 1.116 were not entered.

Therefore, this Preliminary Amendment is being filed consistent with a RCE filed in compliance with 37 CFR 1.114, and the Notice of Appeal is withdrawn.

By this preliminary Amendment, claims 5, 6 and 14 are cancelled and claims 1, 7, 8, 17 and 18 are amended.

Although the final Office Action mailed 6/16/2005 includes at page 7, paragraph 7, a rejection of claim 12, that claim was previously cancelled in an Amendment mailed 11/30/2004. The Examiner should take note of this.

The amended claims are not anticipated by Hirata because Hirata does not disclose the claimed sequence as in the amended claims.

By way of example of the amended claims, amended claim 17 reads as follows:

17. *A method of preparing a scanner to scan a photographic film that may be a positive or negative film type, comprising the steps of successively:*

measuring respective color densities of three different color hues, red, green and blue, in the photographic film;

comparing the color densities to a standard range which indicates an orange bias that is high enough to represent only a negative film type; and

triggering the scanner to treat the photographic film as a negative film type automatically when the color densities are within the

standard range and to otherwise treat the photographic film as a positive film type automatically when the color densities are not within the standard range.

The Examiner has concluded that previously presented claim 17 is anticipated by Hirata, citing col. 9, line 37 – col. 11, line 47; FIG. 3a. This is believed to be in error at least for the following reasons:

1. Hirata does not disclose the claimed step of *comparing the color densities of three different color hues, red, green and blue, in the photographic film to a standard range which indicates an orange bias that is high enough to represent only a negative film type*. With respect to this comparing step, it is assumed that the Examiner relies on col. 10, line 32 – col. 11, line 2 and FIG. 4a (see the rejection of claim 1). However, in this connection Hirata states that "orange mask adjustments *** are made according to the negative/positive determination of a film" (col. 10, lines 32-34). The "negative /positive determination of a film" in Hirata is made during step 6 in FIG. 2a, which is detailed in FIG. 3a (Hirata, col. 8, lines 37-38, 67-68). Step 6, the "negative /positive determination of a film", as indicated in FIG. 2a occurs before the "orange mask adjustments", that is, before an orange mask reading routine (step 9). Thus, the "negative /positive determination of a film" in Hirata is made before the "orange mask adjustments". Accordingly, how can Hirata disclose the claimed step of *comparing the color densities of three different color hues, red, green and blue, in the photographic film to a standard range which indicates an orange bias that is high enough to represent only a negative film type*? The Examiner is requested to answer this question. Moreover, she is requested to point out where in Hirata is the support for her position. A previous request to do so does not appear to be answered.

2. Hirata does not disclose the claimed step of *triggering the scanner to treat the photographic film as a negative film type automatically when the measured color densities of three different color hues, red, green and blue, in the photographic film are within the standard range which indicates an orange bias that is high enough to represent only a negative film type, and to otherwise treat the photographic film as a positive film type automatically when the color densities are not within the standard range*. With respect to this step, it is assumed that the Examiner relies on col. 11, lines 3-5 and FIG. 3a (see the rejection of claim 1). However, lines 3-5 simply state that in the calculation/hue judgment process (step 6 in FIG. 2a) the negative/positive judgment process is first performed (see the first step in FIG. 3a). No further description of the negative/positive judgment process is offered. Also, as indicated above, step 6 in

FIG. 2a (and therefore the first step in FIG. 3a) occurs **before** the orange mask reading routine (step 9 in FIG. 2a).

It is recognized that in FIG. 4a of Hirata there are setting alteration steps for positive and negative modes in accordance with a negative/positive judgment, but this is not based on whether *the measured color densities of three different color hues, red, green and blue, in the photographic film are within the standard range which indicates an orange bias that is high enough to represent only a negative film type*, as in claim 17. Also, see Hirata, col. 10, line 68 – col. 11, line 2. **If the Examiner disagrees, she is requested to point out where in Hirata is the support for her position.**

Accordingly, amended claim 17 is not anticipated by Hirata.

Amended claims 1, 7 and 18 are not anticipated by Hirata and are patentable at least for the foregoing reasons that amended claim 17 is patentable.

The Examiner has not responded to the Applicant's argument in the response to the first Office Action and in the Response under 37 CFR 1.116 that Hirata does not anticipate original claim 1.

The Applicant's argument was that in Hirata there is no description of how the negative/positive judgment process is actually made. All that is stated is that "the negative/positive judgment process is first performed" as a method step. See col. 10, lines 31-34, and col. 10, 67-col. 11, line 7, and FIG. 3a. If the Examiner disagreed, she was requested to specifically identify what she believes is a description to the contrary in Hirata. However, the Examiner's reply was simply to say that Hirata "discloses enough information to illustrate that the negative/positive determination is made by comparing color density on film", and in this connection she refers to FIGS. 2a and 3a-3d, and to col. 9, line 41-col. 10, line 47. This reply, although repeated in the Advisory action, **is believed to be insufficient**, particularly in view of the Applicant's comments regarding the referred to portions of Hirata. Where in FIGS. 2a and 3a-3d, and in col. 9, line 41-col. 10, line 47, is there a disclosure that the negative/positive determination is made consistent with the *comparing* and *setting* steps in claim 1? (In point of fact, there is no such disclosure.) **The Examiner is requested to answer the question. Moreover, she is requested to point out where in Hirata is the support for her position. A previous request to do so does not appear to be answered.**

The Dependent Claims

Since the dependent claims further limit features in the claims referenced above, they cannot be anticipated by Hirata at least for the above-

provided reasons that the latter claims are not anticipated by Hirata. Thus, the dependent claims should be allowed.

Conclusion

The Applicant's remarks above are believed to be fully responsive to the Examiner's rejection of the claims. Allowance of the claims, or a like response from the Examiner, is therefore requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.